



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,673	02/10/2004	Doug Foster	DFI001	1135
28848	7590	03/20/2006	EXAMINER	
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			MEISLIN, DEBRA S	
			ART UNIT	PAPER NUMBER
			3723	
DATE MAILED: 03/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/775,673

Applicant(s)

FOSTER, DOUG

Examiner

Debra S. Meislin

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-13, 17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 3-6, 8-10, 12, 13 and 17 is/are rejected.
- 7) ☒ Claim(s) 7 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3723

1. In accordance with 37 CFR 1.131 and MPEP 715:

“(b) The **showing of facts** shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. **Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.**” (emphasis added)

2. The Declaration filed on October 24, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Borkowski reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Borkowski reference. Applicant has failed to submit evidence to establish diligence, to establish a conception of the invention or to establish a reduction to practice.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Borkowski or Jefferson (4354540).

Meador et al discloses all of the claimed subject matter except for having a distal rubber surface engager. Borkowski or Jefferson disclose a distal rubber surface engager. It would have been obvious to one having ordinary skill in the art to form the

Art Unit: 3723

device of Meador et al with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski of Jefferson.

5. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and further in view of Borkowski or Jefferson (4354540).

Meador et al discloses all of the claimed subject matter except for having a beveled head portion and a distal rubber surface engager. Hallock discloses a beveled "19" head portion. Bond discloses a beveled "9" head portion. It would have been obvious to one having ordinary skill in the art to form the head portion of Meador et al as beveled to impact and countersink a workpiece as taught by Hallock or Bond.

Borkowski or Jefferson disclose a distal rubber surface engager. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with a rubber surface engager to prevent marring of the workpiece as taught by Borkowski of Jefferson.

With respect to claim 9, Bond discloses a retractor "11". It would have been obvious to one having ordinary skill in the art to provide the device of Meador et al with a retractor to permit adjustments to be made as taught by Bond.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and Borkowski or Jefferson (4354540) as applied above, in further view of Eby.

Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool

Art Unit: 3723

"136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. It would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and Borkowski or Jefferson as applied above, in further view of Williams (4299021).

Williams discloses an impact member "7" attached to a striking portion "11". The impact member "7" comprises an attachment portion "9" formed to removably attach an extension "5". It would have been obvious to one having ordinary skill in the art to releasably attach the impact member "28" to the rod "30, 32" of Meador et al to allow to tool to be lengthened or shortened as taught by Williams.

8. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, and Borkowski or Jefferson, as applied above, in further view of Schutz.

Schutz discloses an extender "2" and a cock and release mechanism "8, 9". It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with an extender to force the impact member from the retracted to the extended position to impact a workpiece as taught by Schutz. It would have been obvious to one having ordinary skill in the art to form the device of Meador et al with cock and release mechanism to provide a faster insertion of the fastener as taught by Schutz.

Art Unit: 3723

9. Claims 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, Borkowski or Jefferson, and Schutz as applied above, in further view of Eby.

Eby discloses a handle pole "116" attached to the proximal portion of an impact member and extends beyond a guide member, a sliding attachment portion (see tool "136" slidable on pole "116") whereby the device is usable to set a fastener or as a hammer. It would have been obvious to one having ordinary skill in the art to provide the handle pole "30" of Meador et al with a sliding attachment portion to allow for the impact member to be driven or for the attachment to a tool as taught by Eby.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Hallock or Bond, Borkowski or Jefferson, and Schutz as applied above, in further view of Williams (4299021).

Williams discloses an impact member "7" attached to a striking portion "11". The impact member "7" comprises an attachment portion "9" formed to removably attach an extension "5". It would have been obvious to one having ordinary skill in the art to releasably attach the impact member "28" to the rod "30, 32" of Meador et al to allow to tool to be lengthened or shortened as taught by Williams.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador et al in view of Williams (4299021).

Meador et al discloses all of the claimed subject matter except for forming an attachment portion such that an extension may be removably attached. Williams discloses an impact member "7" attached to a striking portion "11". The impact member

Art Unit: 3723

"7" comprises an attachment portion "9" formed to removably attach an extension "5". It would have been obvious to one having ordinary skill in the art to releasably attach the impact member "28" to the rod "30, 32" of Meador et al to allow the tool to be lengthened or shortened as taught by Williams.

12. Claims 7 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 19 is allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Applicant's arguments filed October 24, 2005 have been fully considered but they are not persuasive.

Since applicant's 37 CFR 1.131 Declaration is ineffective to overcome the Borkowski reference, then Borkowski remains applicable to the rejection of the claims. Additionally, the Jefferson reference has been added in the event applicant perfects the

Art Unit: 3723


Declaration. Applicant's amendment (which includes the Declaration) necessitated this new ground(s) of rejection.

With respect to claims 8, 12 and 17, the Williams reference has been applied which discloses the newly amended subject matter regarding removably attaching an extension to the impact member.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin  
Primary Examiner  
Art Unit 3723

March 16, 2006